

February 10, 2004

after the raising of the pipette assembly, performing a multiple simultaneous testing of the sample.

20. (Original) The method of using a diagnostic pipette assembly for aspirating sample as set forth in Claim 19, wherein the steps include:

lowering and raising the pipette by automated means.

*** * * R * E * M * A * R * K * S * * ***

Applicants herewith submit this Response in a bona fide attempt to advance the prosecution of this case and to answer each and every ground of rejection as set forth by the Examiner. Applicants respectfully request reconsideration of the above-identified application in view of the amendments to the specification, claims and drawings, and the remarks set forth below. Please also note the Applicant's response to the restriction requirement below.

Applicant has amended the drawing and specification in accordance with the Examiner's suggestions where appropriate. The Examiner has made numerous objections, which are believed to be outside the scope of a proper examination of this patent application. Below, Applicant has responded to each and every objection/rejection in the paragraph format that was presented by the Examiner. It is believed that the claims as recited originally clearly distinguish over the cited references of record including the references relied upon by the Examiner. No new matter has been added.

It will be noted that the Examiner states in her Office Action Summary sheet that she is objecting to Applicant's Claims 2, 9, 13 and 15. However, ¶ 14 of her Office Action clearly objects to Claim 14. Applicant requests that the Examiner be as rigid with her own work as she apparently requires of Applicant.

Additionally, Applicant also notes that the Examiner has restricted her examination according to both her Office Action, ¶¶ 1 – 7 and her Summary to Claims 1

February 10, 2004

– 17. Applicant notes that ¶¶ 16, 17, and 33 purport to reject Claims 1 – 18. Applicant does not understand this, other than, it is clear that no extra burden would be on the Office or this Examiner in particular, in search for the remaining claims since apparently she has already done so, at least with regard to Claim 18. Applicant details this further in its response to the Examiner's restriction requirement.

Drawing Objections:

(¶8) The one way valve is clearly show and described in the specification as originally submitted. The Examiner is invited to review and study the Applicant's drawing, Figs. 3 and 8 – 11 as well as the description found at least at the following locations as well as others throughout the specification: p. 5, ll. 15 – 18; and p. 16, ll. 22 – 24 and Claim 15. Additionally, a one-way valve is not new or novel. Applicant is not claiming invention of a one-way valve. In such valves are well known as is their operation. What is new and novel and non-obvious is the combination that Applicant uses which includes the one-way valve.

(¶9) There were two typographical errors in the specifications concerning the mislabeling of reference character 10. Each of these should have been quite obvious to the Examiner and the Examiner should have known that this was a reference numeral change and not a drawing issue.

(¶10) Reference character 26 in Fig. 8 has been changed to 76 as the specification clearly recites and which was more than obvious from the text.

Claim Objections

(¶11) Regarding Claim 2, Applicant traverses the Examiner's objection. Applicant is NOT required to use words only in Merriam-Webster's or anyone else's dictionary. Applicant and the undersigned are entitled under US Patent Law to be their own lexicographer. The term "urgable" is clear in its meaning and conveys the appropriate relationship within the claim and will not be changed.

Claims 9 and 15 have been amended to reflect the Examiner's suggestion.

February 10, 2004

(¶13) Claim 13 has now been amended to clearly reflect that the first end of the tip housing remains open whether the structure for closing or opening the second end of the tip housing is in its first or normal position or its second position, in which the second end of the tip housing opens. Claim 14 is withdrawn.

(¶14) Claim 14 is withdrawn.

(¶17) The plunger is certainly a necessary part of the valve in certain clearly described exemplary embodiments. That does not equate with the plunger being the valve, which would not be a true statement. In any case, the objection/rejection here is not understood by the Applicant. There is no reference to any violation of statute or MPEP section and therefore the objection/rejection is unintelligible and is traversed.

(¶18) The Examiner is invited to review Applicant's specification at 13, lines 13 – 18. While the term "normal" may well refer properly to an orthogonal set of lines. The term "normal" as used throughout the specification is done so correctly despite this not being the connotation here. In English, the same term may well have different meanings and still be used properly. It is not Applicant's place or desire to teach the Examiner English. Needless to say, this objection/rejection is traversed. Applicant asserts that the meaning of "normally urging" is crystal clear in the context of the specification of this application.

(¶19) There is no intelligible objection/rejection of Claim 1. If there were one for the grounds cited, it would be traversed. Claim 1 recites as follows: "a pipette tip assembly connectable to the main pipette housing having a hollow interior defining a second chamber . . ." Applicant does not understand how that is confusing to the Examiner. In any case, this objection/rejection is traversed as being unintelligible and wrong.

(¶20) Claims 1, 2, 5, 9, 11 and 12 have been amended to more particularly point out and clearly define the claims. The term "pipette tip" has been changed to tip assembly.

February 10, 2004

(¶21) There is no intelligible objection/rejection to Claim 2. Applicant submits that Claim 2 is clear and unequivocal and allowable. This objection/rejection is traversed.

(¶22) There is no intelligible objection/rejection to Claim 7. However, Applicant has amended Claim 7 to more clearly point out and distinctly claim the invention. Any objection/rejection is believed overcome.

(¶¶23, 26) There is no intelligible objection/rejection to Claim 13. However, Applicant has amended Claim 13 to more clearly point out and distinctly claim the invention. Any objection/rejection is believed overcome.

(¶¶24 - 28) Applicant has amended Claim 13 to more clearly point out and distinctly claim the invention. Any objection/rejection is believed overcome.

(¶30) There is no intelligible objection/rejection to Claim 15. However, Applicant has amended Claim 13 to more clearly point out and distinctly claim the invention. Any objection/rejection is believed overcome. Moreover, this specific objection/rejection is traversed. Applicant defines a one-way valve in terms of its functionality in Claim 15. Proper enablement has been provided in the specification as noted above. Finally, there is nothing new or novel about a one-way valve. The new and novel feature is how that one way valve is used in combination with the other elements of Claim 15.

(¶31) Applicant has amended Claims 16 and 17 to more clearly point out and distinctly claim the invention. Any objection/rejection is believed overcome. Any surface inherently has an exterior and therefore it is unnecessary to positively recite that inherent part in the claim. This makes a claim less readable and less understandable. That is not the intention of the requirement of antecedent basis in the patent law.

Rejection of Claims 1 - 18 under §102(b) in View of Rutenber

February 10, 2004

It will be noted that despite the Examiner's words to the contrary, she has decided to Examine Claims 1 – 18 and not merely 1 – 17 as stated in her restriction requirement. It is respectfully submitted that the restriction requirement be withdrawn, that the entire first office action be withdrawn as being incomplete and that a new office (non-final) action be mailed to Applicant with an entirely new date and that any fees associated with this Response A be returned to the Applicant.

The Examiner states that Rutenber discloses "a diagnostic pipette assembly including structure for automation. Rutenber, itself states that it is a Cask or Tank Gage NOT a pipette. Rutenber states that "A" is part of a metallic casing, comprising a tube. (Col. 1, ll. 42-43). Rutenber further states that "M" is glass tube and further states, "The said tube A is provided on diametrically opposite sides with longitudinal slots P through which the glass tube M is clearly visible and through which, furthermore, the level of liquid may be readily ascertained by holding the device to the light in an obvious manner." Col. 2, ll. 92-95.

Applicant's Claim 1 recites first and second chambers. Rutenber fails to disclose the same. For that reason alone Claim 1 is not anticipated by Rutenber. There is at most one chamber in Rutenber. "Mounted in the threaded enlarged portion G of said central opening in said head C is a small tube H." This would be impossible if there were first and second chambers. Moreover, after carefully reviewing the Examiner's own Office Action, the entirety of ¶33, the Examiner herself fails to state that Rutenber discloses this element of Applicant's Claim 1.

It is also clear that liquid entering from the valve end of Rutenber through valve seat D does not enter the "central opening". As stated at ll. 69-80 of Rutenber, "... so that by pressing on the latter to raise said valve against the action of said spring the said stem L will strike said cross-head J, which serves as a stop to limit the movement of said valve before the lowermost end of said head C comes in contact with the bottom of the cask or tank or other means bearing on said shank F to raise said valve, **thus preventing said inlet-opening for liquid from being sealed by contact with such bottom in an obvious manner.**" Emphasis supplied.

February 10, 2004

This is further supported by Rutenber's statements at ll. 46-49, "... the opening in the upper head B serving as a passage for air and the opening in said head C serving as a passage for liquid;" There would be no reason for head B to pass air if there was communication between the tip and head B. It is respectfully submitted that if there is fluid communication between the head C and head B when the valve is opened that such fluid must flow through openings L. Clearly Applicant has no such openings and as such is not anticipated by Rutenber.

It is further believed as near as can be told from the rather terse disclosure of Rutenber that the tubes are glass to permit the liquid to be viewed between intermediate glass tubes and not in the central chamber as claimed by Applicant. Again this a teaching in an opposite direction from Applicant's Claims. As discussed in latter claims below, found in the first chamber of Applicant's claimed structure is the means for evaluating the liquid. Since that is not what Rutenber is doing with the liquid, it is not surprising that the structures would be teachings in opposite directions.

Even supposing there were two chambers, clearly those two chambers aren't in fluid communication as described in Applicant's invention and particularly pointed out and set forth in Claim 1, "... allowing for the plunger to be urged to a second position wherein the plunger opens the distal end and allows fluid communication from the distal end of the tip assembly through the second chamber and into the first chamber.

In fact, these elements function so differently that it can be fairly said that Rutenber is a teaching in an opposite direction from Applicant's invention as set forth in Claim 1 and the remaining claims. As such it should be immediately withdrawn from use here.

Finally, Applicant submits that there is no suggestion in Rutenber to use his structure in connection with a diagnostic pipette for automatic sampling. Given the massive weight of Rutenber several glass tubes and a metallic layer, it would clearly not function in any realistic way with the diagnostic instrument 50 as set forth as an

February 10, 2004

exemplary embodiment in Applicant's specification. Or, would such a Rutenber structure be suitable in any way to any known or predicted diagnostic device. Thus, the suggestion to use Rutenber came not from the reference itself, but from Applicant's own disclosure. As such, this is improper hindsight and makes the reference wholly invalid as a teaching or anticipatory reference.

In Claim 2, the one-way valve allows for communication between the first and second chambers in Applicant's invention. Again, this appears, as near as Applicant can tell from the Rutenber disclosure to be a teaching in an opposite direction from Rutenber.

Claim 15 specifically recites the capability of "automatically aspirating sample into the pipette housing." There is no suggestion mention or teaching whatsoever of such automation in Rutenber.

Claims 13 and 16 both discuss the window feature of Applicant's invention. Claim 13 recites at least one window and Claim 16 recites a series of windows. While in some contorted way the Examiner may state that Rutenber discloses a single window, clearly there is no series of windows disclosed as recited in Claim 16. Additionally since it is respectfully submitted that Rutenber does not contain liquid in the "central chamber", any Rutenber window would clearly be unlike the window of Applicant's claims, and most notably Claim 16. The same is also true of Claim 17.

Rejection of Claims under §102(b) in View of Seraphin

Claims 1-5, 7, 8, 11 and 13-15 are rejected by the Examiner on the basis that they are anticipated by Seraphin. The Examiner states that Seraphin discloses "a diagnostic pipette assembly including structure for automation. Seraphin, itself states that it is a automatic tank gage and NOT a pipette. Just like Rutenber, Seraphin has only one chamber. When the valve opens, the fluid admitted is encased between the various concentric glass tubes and outer metallic casings. This is nothing at all like the structure of Applicant's claims. In fact, the structure of Rutenber and Seraphin are remarkably identical.

February 10, 2004

As stated in Seraphin at p. 2, ll. 40-49, "... water then enters the gauge through ports e e and by valve g into the glass tube p in which it rises to the level of the water in the tank proper.

When the gauge rests on the bottom of the tank, gasoline flows into the tube p through ports m in the housing l and stands in the tube above the water to a height equivalent to the height of the zone of gasoline."

Clearly tube p is not the equivalent of the first chamber of Applicant's claimed invention nor does opening the valve allow the chambers to communicate. Again there is only one chamber for Seraphin unlike the two chambers capable of being in fluid communication of Applicant's claims.

Since the structures of Seraphin and Rutenber are for the purposes of this examination identical Applicant merely repeats and restates each and every remark above with respect to Rutenber. Applicant specifically notes that the suggestion for the disclosure itself is found in Applicant's disclosure and not in Seraphin itself. Again, this is impermissible hindsight. The required length alone of Seraphin eliminates it as a valid reference.

As stated in Seraphin at p.1, ll. 93 – 97, "In practice, the length of the gauge from the lower end of housing d to the ports m in housing l is made at least equal to the maximum depth of liquid in the size tank with which it is to be used." It is respectfully submitted that such a necessary of Seraphin would render any structure taught by Seraphin useless in the automated diagnostic instrument of Applicant's invention.

Additionally, the multiple concentric tubes including the casing and the concentric glass tube required by the Seraphin disclosure would also yield a device totally incapable of being used in the environment of Applicant's disclosure. That environment is set forth as a limitation in the claims and particularly as "diagnostic pipette assembly".

Given that both references are gauges and not diagnostic pipette assemblies, it is neither surprising or even unlikely that this would be the case.

Rejection of Claims under §103 in View of Rutenber and Seraphin

Since neither of the references is a teaching reference, neither can serve the purposes of being a valid reference and therefore neither reference renders obvious

February 10, 2004

any of the claims of Applicant's claimed invention. Additionally, Applicant repeats and restates its comments herein as if set forth in full above.

Restriction Requirement Response

ELECTION OF SPECIES

Responsive to the Examiner's requirement under 35 U.S.C. §121 that a single disclosed species be elected for prosecution on the merits, Applicants elect to prosecute the invention of Species I, Figs. 1-4, on which Claims 1-9, 11-28 and 30-42 read. Accordingly, Applicants at this time withdraw Claims 10 and 29 from consideration as being drawn to non-elected species. However, Applicants regard this withdrawal as without prejudice pending the Examiner's consideration of the traversal that follows herein.

TRAVERSAL OF REQUIREMENT FOR ELECTION OF CLAIMS

Applicant confirms the election made to Claims 1 – 12, now Claims 1 - 17.

Applicant respectfully requests reconsideration of the instant requirement for election of claims. Applicant hereby preserves the instant request for reconsideration for subsequent petition and appeal. The Examiner states that there are the two sets of claims presented in the above captioned patent application are patentably distinct from one another, but which have acquired a separate status in the art. The Examiner takes the position that the Application contains claims directed to the following patentably distinct set of claims:

Claims 1-17, drawn to a diagnostic pipette assembly; and

Claims 18-20, drawn to a method of using the same.

February 10, 2004

In accordance with 35 U.S.C. §121, Applicants have elected the invention set forth in Claims 1-17. Applicants believe all embodiments of the invention are a single inventive concept and all claims are generic to that single inventive concept. Upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 141.

Section 803 of the MPEP states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

MPEP 803, Rev. 2, July, 1996 at 800-3. The same section further states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) The inventions must be independent (see MPEP § 802.01, §806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - §806.05(i)); and

(2) There must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and §808.02).

MPEP §803, *supra* at 800-3. It is the duty of the Office to allow an inventor to embrace in one application contrivances, however distinct, which mutually contribute to produce a unitary result. *Ex parte Kuh*, 1876 C.D. 190 (Comm'r). Applicants submit that the embodiments of the present Application all comprise a single inventive concept and all operate to produce the objects of the invention.

As for the second criterion for restriction that must be shown by the Examiner -- that of a serious burden upon the Office -- MPEP § 803 states that examiners must provide reasons and/or examples to support conclusions, and further states that a

February 10, 2004

serious burden may be *prima facie* shown by "separate classification, separate status in the art, or a different field of search as defined in MPEP §808.02." *Ibid.* at 800-4.

However, Applicants note that the Examiner has somehow managed to reject Claim 18 despite this alleged burden. Applicant's submit that there is really no burden at all and request an immediate withdrawal of the restriction requirement.

35 U.S.C. §121 authorizes the Commissioner to restrict an invention only where two or more independent and distinct inventions are claimed in one application. Applicants agree with the Examiner's conclusion that two or more inventions are present which are patentable over each other. However, the Examiner has not shown that the embodiments cannot be treated as comprising a single inventive concept, nor that a serious burden would result unless restriction were required. Therefore, the propriety of the instant requirement for election of species has not been established.

Withdrawal of the requirement for restriction will not cause the Examiner to encounter serious burden. The present restriction requirement is not justified under either 35 U.S.C. §121, 37 C.F.R. §141 et seq., or MPEP Chapter 800. Withdrawal of the instant requirement for restriction is appropriate. Accordingly, Applicants respectfully request that the requirement be withdrawn and that the entire Application be examined on the merits.

CONCLUSION

Applicants herewith submit this Response A in a bona fide attempt to advance the prosecution of this case and to answer each and every ground of rejection as set forth by the Examiner. Applicants respectfully request reconsideration of the above-identified application in view of the amendments to the specification, claims and drawings, and the remarks set forth above. If, after reading this Response A, the Examiner has any questions or issues which she would like to discuss with the

February 10, 2004

Applicant's counsel in furtherance of the prosecution of this case, he is invited to contact the undersigned at the number given below.

Respectfully submitted,

PENINSULA IP GROUP

A handwritten signature in black ink, appearing to read "Douglas A. Chaikin". The signature is written in a cursive, flowing style.

Douglas A. Chaikin, Esq.

2290 North First Street, Suite 101
San Jose, CA 95131
Telephone No.: (408) 965-4001
(408) 965-4008

1400 U.S. POSTAGE P 85546902
0990001.290 FEB 10 2004
3497 MAILED FROM ZIP CODE 95131

First Class Mail
First Class Mail

FROM:
Peninsula IP Group
2290 North First Street, Suite 101
San Jose, California 95131

TO:
Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450